UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,371	02/10/2005	Richard Ronald Baynham	265330US6XPCT	4850

22850 7590 02/22/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
HOOK, JAMES F	

ART UNIT	PAPER NUMBER
3754	

NOTIFICATION DATE	DELIVERY MODE
02/22/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/524,371	BAYNHAM ET AL.	
	Examiner	Art Unit	
	James F. Hook	3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The examiner acknowledges applicants numbering scheme and will treat the claims as provided in the amendment of December 3, 2007.

Specification

The use of the trademark PROGUARD CRB has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

As set forth above the generic terminology is also required, and it is not clear that the part of the specification that appears in the sentence before the trademark name is in fact the generic terminology for the trademark material or whether such is an equivalent material used but may not be the same. It should be clarified what the generic terminology is for the trademarked material in any subsequent response.

Also, the term TEFLON appears in the specification and should be provided with it's generic terminology as well.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The wording of claim 11 is considered indefinite where the scope of the claim is not clear with regards to whether curable resin layer contains both ceramic filler and chopped carbon fiber, or whether such is in an alternative material to be used in place of the ceramic filler, where the specification discusses that the carbon fibers are optional, therefore it is believed that it is possible that the chopped carbon fibers are an option to the use of ceramic filler but such is not clear based upon the manner in which the claim is worded, and therefore the claim is considered indefinite as well as all the claims that depend therefrom. It is noted that applicant attempted to correct this, however, the amended language still does not make it clear that the curable resin contains both ceramic particulate filler and chopped carbon fibers when such is not stated in these terms, and still seems unclear when the specification suggests the carbon fibers are optional and the way such is claimed seems to be suggesting this feature. However, the examiner feels that based upon the arguments that applicant is intending to claim a curable resin with both a ceramic particulate filler and chopped carbon fibers and will be treated as such in the following rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hwang. The patent to Hwang discloses the recited the recited prefabricated tubular body 2 for use downhole comprising integral centralizer formations 4 formed as projections molded to the tubular body by using heat and pressure to attach them to the tubular where such are made of curable resins such as thermoplastics, where such can be provided with ceramic particulate filler material, in addition thereto fillers including antistatic agents can be provided, where carbon black fibers are fillers used to provide antistatic properties, the limitations of claim 12 appear only to recite method steps which would not change the final product materially of providing a projection that is heat and pressure molded of curing resin onto a pipe, the same is true of claim 13 which merely discloses the apparatus, specifically the mold, that is used to form the projections, both claim 13 and 12 hold no patentable weight on an article claim when such are not materially changing the final product, after forming the projections on the pipe the pipe can be coated with a polyester film which is a resin and coated thereto thereby meeting claims 14-16, the tubular core is placed within other objects by sliding and therefore is capable of permitting rotation as well, and where the projections are formed as ribbing or stand off projections. The patent to Hwang discloses all of the recited material, however, without a clear understanding of whether carbon black is actually required in the material as such is considered indefinite above, if such were considered to be a requirement of the material recited in claim 11, then Hwang discloses the use of antistatic fillers and it is

considered old and well known in the art that carbon black fibers are used as antistatic fillers in pipes, therefore it would have been obvious to modify the material in Hwang that discloses antistatic fillers to specifically use a known filler such as carbon black fibers to achieve antistatic properties as such would only require routine skill and knowledge in the art to select an appropriate material for it's specific use.

Response to Arguments

Applicant's arguments filed December 3, 2007 have been fully considered but they are not persuasive. With respect to Hwang, as set forth above the recitation of including an antistatic additive in the projections is inherently claiming materials such as carbon fibers, or such can be considered an obvious modification as carbon fibers are known in the art to be antistatic additives. There is no argument directed at this rejection which was provided in the previous office action, only an argument that Hwang did not disclose a carbon fiber, however, the examiner had remedied this with the alternate 102/103 rejection to cover whether the carbon fibers were in fact being claimed by applicant and whether such were taught by the recitation in Hwang of an antistatic additive. Since there was no particular argument offered to this viewpoint the examiner is not required to provide support for the statement that carbon fibers are known in the art to be antistatic additives, however, such is evidenced by the reference to Platusich, and Wellman (229 and 305), therefore this rejection is still considered pertinent and still stands.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Platusich, Wellman (229), and Sas-Jaworsky disclosing state of the art spacers, including where carbon fibers can be included for static dissipation of charge.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James F. Hook
Primary Examiner
Art Unit 3754

JFH